

## **REMARKS**

The Office Action dated June 28, 2004, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 1-3, 6 and 7 have been amended. No new matter has been added. Support for the amendment to the claims can be found through the specification and in the drawings as originally filed. Claims 1-8 are currently pending in the application with claims 1, 2, 7, and 8 having been allowed. As such, claims 3-6 are respectfully submitted for consideration.

The Applicants wish to thank the Examiner for allowing claims 1, 2, 7 and 8.

Claims 3-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nakayama et al. (Japanese Patent Publication No. 6-159073, "Nakayama"). Claims 4 and 5 depend from claim 3. To the extent that this rejection remains applicable to the claims currently pending, Applicants hereby traverse the rejection, as follows.

Claim 3 recites an exhaust passage structure in an outboard engine system having a swivel shaft for steering of the outboard engine system in which a catalytic converter for purifying an exhaust gas discharged from an engine is mounted in an exhaust passage for guiding the exhaust gas. The exhaust passage structure comprises at least a portion of the exhaust passage integrally formed in a case member, the case member being disposed under an engine block to accommodate a drive shaft therein for transmitting a driving force from the engine to a propeller. The case member is connected to the swivel shaft. A connection into which the exhaust passage opens is formed in a sidewall of the case member. An exhaust passage-defining member is disposed under the engine block. The catalytic converter is

disposed in a space surrounded by the case member and an exhaust passage-defining member so as to be held by the exhaust passage-defining member. The exhaust passage-defining member is detachably coupled to the connection of the case member to permit the exhaust gas to flow thereinto.

Claim 6 recites an exhaust passage structure in an outboard engine system having a swivel shaft for steering of the outboard engine system in which a catalytic converter for purifying an exhaust gas discharged from a 4-cycle engine is mounted in an exhaust passage for guiding the exhaust gas. The exhaust passage structure comprises at least a portion of the exhaust passage integrally formed in a case member, the case member being disposed under an engine block to accommodate a drive shaft therein for transmitting a driving force from the engine to a propeller. The case member is connected to the swivel shaft. A connection into which the exhaust passage opens formed in a sidewall of the case member. An exhaust passage-defining member is disposed under the engine block. The catalytic converter is disposed in a space surrounded by the case member and an exhaust passage-defining member so as to be held by the exhaust passage defining member, the exhaust passage defining member being detachably coupled to the connection of the case member; and wherein the exhaust passage-defining member includes an opening to permit the exhaust gas to flow thereinto.

With respect to claims 3 and 6, the Applicants submit that Nakayama fails to disclose or suggest the claimed features of the invention. Claims 3 and 6, as amended recite "at least a portion of the exhaust passage integrally formed in a case member, the case member being disposed under an engine block to accommodate a drive shaft therein", and "an exhaust passage-defining member being disposed under

the engine block". The Office Action took the position that elements 110 and 110a of Nakayama were comparable to the exhaust passage-defining member recited in the claims. See page 3 of the Office Action. However, Nakayama does not disclose or suggest "at least a portion of the exhaust passage integrally formed in a case member, the case member being disposed under an engine block to accommodate a drive shaft therein", and "an exhaust passage-defining member being disposed under the engine block". In contrast, Nakayama discloses that the elements 110, 110a are disposed above the engine. See Figure 2 of Nakayama. For at least this reason Nakayama fails to disclose or suggest the claimed features of the invention.

Also, claims 3 and 6 recite "at least a portion of the exhaust passage integrally formed in a case member, the case member being disposed under an engine block." The Office Action took the position that housing 12a of Nakayama was comparable to the case member. In contrast, housing 12a and also housing 12b are disclosed as "covering the engine". See English Abstract of Nakayama. As such, the housing 12a is not disclosed as being disposed under an engine block, and for at least this reason Nakayama fails to disclose or suggest the claimed features of the invention.

Further, claims 3 and 6 recite, "a connection into which said exhaust passage opens, the connection . . . formed in a sidewall of said case member." The Office Action took the position that element 108 of Nakayama was comparable to the connection. However, Nakayama does not disclose that element 108 is formed in a sidewall of the housing 12a. As such, Nakayama fails to disclose a connection being formed in a sidewall of the case member as recited in claims 3 and 6.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, "[a]


claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim . . . the identical invention, specifically, [t]he identical invention must be shown in as complete detail as contained in the claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The Applicants respectfully submit that Nakayama does not disclose or suggest the case member, connection, and exhaust passage-defining member as arranged in claims 3 and 6. Accordingly, Nakayama does not anticipate claims 3-6, nor are claims 3-6, obvious in view of Nakayama.

For at least the above-noted reasons, it is submitted that claims 3 and 6 are allowable over the cited prior art. As claim 3 is allowable, Applicants submit that claims 4 and 5, which depend from allowable claim 3, are likewise allowable. For similar reasons, Applicants submit that claim 6 is allowable over the cited prior art. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing attorney docket no. 107348-00219.

Respectfully submitted,



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Enclosures: Information Disclosure Statement  
PTO Form 1449 w/1 reference

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